

REMARKS

Reconsideration of the application in view of the present amendment is respectfully requested.

By the present amendment, the specification has been amended to more precisely describe a drawing figure. Claim 2 has been canceled. Claim 1 has also been amended to more clearly define the present invention. Claim 4 has been amended to correctly claim the disclosed structure.

Based on the foregoing amendments and the following remarks the application is deemed to be in condition for allowance and action to that end is respectfully requested.

I. Rejection Under 35 U.S.C. § 112

The Examiner rejected claim 4 under 35 U.S.C. § 112, first paragraph, for allegedly not being supported by the specification. As noted above, the specification has been amended to more precisely describe the drawing figure on which claim 4 is based. Claim 4 was also correspondingly amended.

In view of the above, it is respectfully requested that the rejection of claim 4 under 35 U.S.C. § 112 be withdrawn.

II. Rejection of Claims Over the Prior Art

The Examiner rejected claims 1, 2, 4, 5 under 35 U.S.C. § 103(a) as being unpatentable over Ichikawa, et al., JP 11-315,794 (Ichikawa). Claims 3, 6, 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ichikawa in view, respectively of Hettinger, U.S. Patent No. 1,136,957 (Hettinger), DE 42 37 972 (DE '972), and Spencer, U.S. Patent No. 288,728 (Spencer).

It is respectfully submitted that claims 1 and 3-7 are patentable over the cited references. Specifically, none of the prior art, including Ichikawa, discloses or suggests a tempering component arrangeable between the suction side flange of the pump and the recipient connection flange, as recited in claim 1, as recognized by the Examiner.

The Examiner asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to move the tempering component so that it is arranged between the suction side flange of the pump and the recipient connection flange in order to cool the air that passes through that area. Applicant respectfully disagrees with this assertion. Firstly such rearrangement of the tempering component would be contrary to express

teaching of Ichikawa to provide the tempering component at the pump outlet to prevent the temperature rise at the outlet and accumulation of the material gas sucked into the pumping chamber.

The Court of Appeals for Federal Circuit held that

If propose modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

The provision of the tempering component in Ichikawa at the suction size would not remove heat at the outlet side which is generated by compression of the gas and losses in the pump drive.

Secondly, according to the present invention, the tempering component is primarily used as a thermal barrier between the pump and the recipient to prevent transfer of heat from the recipient to the pump.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that at least the third element of *prima facie* obviousness has not been established.

All of the claim limitation criterium requires that “all elements of a claimed invention be arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987).

In view of the above, it is respectfully submitted that Ichikawa does not make obvious the present invention as defined in Claim 1, and the present invention is patentable over Ichikawa.

Heffinger, DE '972, and Spencer likewise do not disclose the novel features of the present invention, as defined in claim 1.

Accordingly, it is respectfully submitted that claim 1 is allowable.

Claims 3-7 depend on claim 1 and are allowable as being dependent on an allowable subject matter.

COMMENTS

Enclosed herewith is a new Declaration requested by the Examiner.

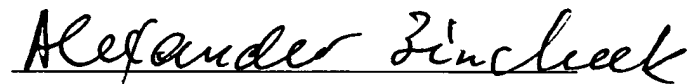
Also enclosed is an Information Disclosure Statement that submits the prior art cited during the prosecution of the corresponding European application on which a European Patent EP 1 447 567 B1 issued. Claim 1 substantially corresponds to claim 1 of the issued European Patent.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, reading "Alexander Zinchuk". The signature is written in a cursive style with a horizontal line underneath the name.

Alexander Zinchuk, Reg. No. 30,541

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